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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,590	11/12/1999	ANDREA CONCANNON	P/2167-125	9576
2352	7590	12/01/2003	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				PWU, JEFFREY C
ART UNIT		PAPER NUMBER		
3628				

DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/438,590	CONCANNON ET AL.	
	Examiner	Art Unit	
	Jeffrey Pwu	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 8/29/2003 amendment.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Potter et al. (US 5,787,402).

Potter teaches a system and method for processing funds transfer from a customer of financial institution, the system comprising:

➤ a first processor receiving a bulk file (batch file; 116) from the customer, the bulk file containing a plurality of funds transfer transactions, the first processor grouping the plurality of funds transfer transactions into funds transfer transactions requiring a foreign exchange operation, denoted as foreign exchange funds transfer transactions, and funds transfer transactions not requiring a foreign exchange operation, denoted as same currency funds transfer transactions (bank 1);

➤ a second processor coupled to the first processor, the second processor receiving the same currency funds transfer transactions not requiring a foreign exchange operation from the first

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processor, the second processor generating first funds transfer instructions in response to the same currency funds transaction (bank 2);

➤ a funds transfer processor coupled to the second processor, the funds transfer processor receiving the first funds transfer instructions from the second processor and executing the received first funds transfer instructions by transferring funds to a funds transfer processor of another financial institution (col.15, lines 16-60);

➤ a trading processor coupled to the first processor, the trading processor receiving the foreign exchange funds transfer transactions from the first processor, the trading processor executing a foreign exchange operation in response to the received foreign exchange funds transfer transactions (118; col.4, line 45-col.13, line 10);

➤ the trading processor is coupled to the second processor, the trading processor forwarding to the second processor the foreign exchange funds transactions and funds resulting from the foreign exchange operation;

➤ the second processor generating second funds transfer instructions in response to the foreign exchange funds transfer transactions and funds resulting from the foreign exchange operation, and the funds transfer processor receiving the second funds transfer instructions from the second processor and executing funds to a funds transfer processor of another financial institution (bank 2);

➤ a link coupling the first processor to a system of the customer, wherein the customer system transmits the bulk file to the first processor (batch file);

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➤ a firewall disposed in the link coupling the first processor to the customer system (fig.2; col.3, lines 12-17);

➤ a market link from the trading processor to a foreign exchange market, wherein the trading processor receives real time foreign exchange rates over the link (col.3, lines 19-45);

Response to Arguments

3. Applicant argues that the *Potter* reference does not teach “not requiring foreign exchange operation” and “funds transfer transactions requiring a foreign exchange operation.”

In contrary, the prior art reference discloses:

“FX Order Server (102)

This server handles the tracking of leave orders for spot and forward orders, to be executed by FX Trade Server, in an Order Blotter. The FX Order Server provides for varying degrees of automatic and manual leave orders and uses the Rate Server to track and match a leave order's desired rate.

Payment Order Server (104)

This server handles bank-to-bank money orders and allows the creation of an FX transaction out of a foreign payment. The Payment Order Server breaks incoming payment orders down into their individual components before forwarding the FX trade components to the FX Trade Server for execution. The FX Trade Server, in turn, converts the trades' foreign currency

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amounts into USD. The Payment Order Server receives money orders via either the Society for Worldwide Interbank Financial Telecommunication (SWIFT) Agent Server 122 or the Batch File Transfer Server via direct interactive log-in by a Payment Order Server" (col.5)

Potter reference inherently show not requiring foreign exchange operation and those "funds transfer transactions requiring a foreign exchange operation" by breaking incoming payment orders down into their individual components before forwarding the FX trade components to the FX Trade Server for execution.

With respect to the argument that the Potter reference does not teach the first processor of claim 1 separates the transactions into those requiring foreign exchange operation and those not requiring foreign exchange operations.

Firstly, the prior art reference discloses this limitation in col.5, "...varying degrees of automatic and manual FX orders" inherently separate the transactions into those requiring foreign exchange operation and those not requiring foreign exchange operations.

Secondly, it is noted that the features upon which applicant relies (i.e.,separates the transactions into those requiring foreign exchange operation and those not requiring foreign exchange operations) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Applicant also argues that the prior art does not show “grouping the plurality of funds transfer transactions into funds transfer transactions requiring foreign exchange operation ...and funds transfer transactions not requiring a foreign exchange operation.”

4. In contrary, the prior art reference further discloses a FX network servers including FX trade server, FX order server, payment order server, batch file server, transaction handoff server, swift agent server, and a FX GUI trade tool to allow users to specify various specific tasks, including grouping the plurality of funds transfer transactions into funds transfer **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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transactions requiring foreign exchange operation or funds transfer transactions not requiring a foreign exchange operation, to facilitate a customized FX automated fund transfer.

5. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey Pwu whose telephone number is (703) 308-7835.



26 November 2003

**JEFFREY PWU
PRIMARY EXAMINER**